

REMARKS

The applicant has carefully considered the Office action dated May 18, 2005 and the references it cites. By way of this Response, claims 1, 23, 35 and 36 have been amended, claim 34 has been cancelled, and claim 37 has been added. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

As an initial matter, the Office is respectfully requested to acknowledge the priority claim of this application to German application 101 36 287.0 via the parent PCT application.

The Office action identified the application as containing seventeen (17) patentably distinct species of the claimed invention. Because of the highly unusual and onerous nature of this election requirement (e.g., a seventeen way election requirement on only 30 claims), the undersigned discussed this election requirement with Supervisor Michael Carone over the telephone on June 15, 2005. Specifically, the undersigned asked Supervisor Carone to review the election requirement for abuse of discretion. Examiner Carone indicated that, although he had signed off on the action, this application was outside of his area of authority in that he was substituting for Supervisor Luu during her maternity leave. However, Examiner Carone reminded the undersigned that the applicant had the right to petition for overturning the election requirement for abuse, if desired, and further indicated that he understood that the Examiner was using the election

requirement in an effort to lighten his workload. Examiner Carone expressed sympathy for the heavy workload of the examiners in this art unit.

As set forth in detail below, without denying that the claims are patentably distinct, applicant traverses this election requirement. Subject to this traversal and in accordance with the requirements of 37 C.F.R. § 1.143, applicants hereby provisionally elects Species A for further prosecution in this application. As required by the Office action, applicants also elect sub-species 1, and sub-sub-species f. As shown in the following chart (wherein "G" represents generic), claims 1, 2, 20, 22-27 and 35-37 read on the elected species (i.e., A, 1, f). Claims 1, 2, 20, 22, 23, 27 and 37 are also generic to ALL SPECIES.

Claim	A	1	2	a	b	I	II	III	c	d	i	ii	e	f	B	1	2
1	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G
2	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G
3	G	G	G	G											G	G	G
4	G	G	G	G											G	G	G
5	G	G	G	G											G	G	G
6	G	G	G	G											G	G	G
7	G	G	G		G	G	G	G							G	G	G
8	G	G	G		G	G	G	G									
9	G	G	G						G						G	G	G
10	G	G	G						G						G	G	G
11	G	G	G							G	G	G			G	G	G

12	G	G	G							G	G	G			G	G	G
13	G	G	G							G	G	G			G	G	G
14	G	G	G							G	G	G			G	G	G
15	G	G	G							G	G	G			G	G	G
16	G	G	G							G	G	G			G	G	G
17	G	G	G							G	G	G			G	G	G
18	G	G	G							G	G	G			G	G	G
19	G	G	G							G	G	G			G	G	G
20	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G
21	G	G	G										G		G	G	G
22	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G
23	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G
24	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	
25	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G		G
26	G	G	G											G	G	G	G
27	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G
35	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	
36	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G		G
37	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G	G

Reconsideration and withdrawal of the restriction requirement is
requested in view of the following remarks.

It is respectfully submitted that the examiner has not met the burdens required to issue a proper restriction requirement¹. The M.P.E.P. clearly and unequivocally states that there are two criteria which *must* be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803). As explained below, the Office action ***fails to meet either of these two required criteria***. Accordingly, the restriction requirement is procedurally improper and must be withdrawn.

M.P.E.P. § 808 sets forth an examiner's burden under the first required criteria of making a restriction requirement. Specifically, M.P.E.P. § 808 states: "[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon the restriction therebetween...." MPEP § 816 expounds upon this requirement:

The particular reasons relied upon by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. *A mere statement of conclusion is inadequate*. The reasons upon which the conclusion is based should be given.

(emphasis added).

¹ "Restriction, a generic term, includes the practice of requiring an election between distinct inventions ... and the practice relating to an election between independent inventions." MPEP § 802.02.

The Office action does not meet this requirement. Instead, the Office action conclusorially states “this application contains claims directed to the following patentably distinct species of the claimed invention” ***but does not provide any reason for such a conclusion.*** As noted in the above quote of MPEP § 816, “A mere statement of conclusion is inadequate” as a reason for requiring restriction/election. Accordingly, the restriction/election requirement fails to meet the first criteria of MPEP § 803 because it ***fails to provide any reasoning whatsoever*** as to why the inventions are distinct or independent. Therefore, on this basis alone, the requirement for election must be withdrawn.

The second requirement that a restriction requirement must meet under MPEP § 803 is a showing that a serious burden will be placed on the examiner if restriction is not required. “For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” (M.P.E.P. § 803).

In this instance, although the Office action identifies seventeen species and subspecies that the examiner believes to reflect patentably distinct species, it ***fails to show*** that the alleged species (a) are separately classified, (b) have a separate status in the art, or (c) require different fields of search. Indeed, the Office action makes ***absolutely no effort*** to show a serious burden would be placed on the Examiner if restriction were not required. Thus, it is clear that the Office action also fails to address the second required criteria for restriction set forth in the M.P.E.P. In view of the following mandate, this

failure to address the second required criteria for issuing a restriction requirement is particularly egregious:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). All of the claims of this application can be examined together without serious burden on the examiner. Therefore, the Office **must** examine it on the merits irrespective of whether it includes claims to distinct or independent inventions.

From the foregoing, it is plainly evident that the Office action fails to meet the criteria for issuing a restriction/election requirement. In particular, ***the Office action fails to provide even a shred of evidence*** that (1) the inventions are independent or distinct as claimed; or, (2) that there would be a serious burden on the examiner if restriction is not required. Failure to meet either of these criteria renders a restriction requirement improper. Failure to meet both of these criteria renders a restriction requirement unconscionable. Accordingly, the applicant respectfully submits that the requirement for restriction must be withdrawn.

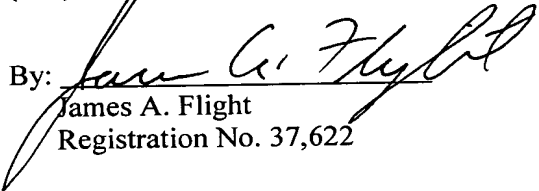
Before closing, the applicants note that the amendments made throughout the claims are either broadening or clarifying and, thus, not necessary for patentability, with the exception of the addition of the phrase “to form a rear grip element” to the claim 1. All other amendments were not necessary for patentability in that they are either broadening or are merely clarifying in that either (a) the amended claims are intended to state the same

thing as the claim prior to amendment (i.e., to have the same scope both before and after the amendments) in a more easily understood or more conventional fashion, or (b) the amended claims are dependent on an allowable claim so that any refinement of the dependent claim was not required for patentability, but was made to clarify the claim. Consequently, other than the noted addition of the "rear grip element" to claim 1, the amendments made in this paper do not give rise to prosecution history estoppel or limit the scope of equivalents of the claims under the doctrine of equivalents.

The Commissioner is hereby authorized to refund any overpayment and charge any deficiency in the amount enclosed or any additional fees which may be required during the pendency of this application under 37 CFR 1.16 or 1.17 to Deposit Account No. 50-2455. A copy of this paper is enclosed.

Respectfully submitted,

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